

### **Remarks**

This communication is considered fully responsive to the Office Action. Claims 1-24 were examined. Claims 1-24 stand rejected. Claims 1, 12, and 24 are amended. No claims are canceled. New claims 25-30 have been added. Reexamination and reconsideration of the pending claims are respectfully requested.

It is noted that claim 24 is amended to correct a minor typographical error and is not being amended for reasons of patentability.

Applicant appreciates the Examiner withdrawing the rejections and making this a non-final Office Action.

### **Claim Rejections - 35 U.S.C. 112**

The Office Action rejected claims 23 and 243 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office Action states that the disclosure in paragraph [0039] is insufficient to support the recitation in claim 23 of “calculating a confidence factor relating to the matched inference data to rate how closely the inference metadata matches the captured image. Claim 24 was rejected as being dependent on claim 23. Applicant respectfully traverses this rejection.

The Patent Office is required to assume that the specification complies with the enablement provision of Section 112 unless it has acceptable evidence or reasoning to suggest otherwise. See, for example, *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1979). The Patent Office must provide reasons, supported by the record as a whole, why the specification is not enabling.

The Office Action states that “[t]here is no disclosure as to how this factor is actually generated. Similarly, there is no description of how the confidence factor is used to determine the closeness of the match between the metadata and the image data. Therefore, one of ordinary skill in the art would have to perform undue experimentation . . . .”

The fact that experimentation may be complex does not necessarily make it undue if the art typically engages in such experimentation. *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988). That is, the test of enablement is not whether any experimentation is required, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 190 USPQ 214 (CCPA 1976).

The factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue” include, but are not limited to, the following:

- the breadth of the claims;
- the nature of the invention;
- the state of the prior art;
- the level of one of ordinary skill;
- the level of predictability in the art;
- the amount of direction provided by the inventor;
- the existence of working examples; and
- the quantity of experimentation needed to make or use the invention

based on the content of the disclosure.

See, for example, MPEP 2164.01(a). It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. MPEP 2164.01(a). The rejection in this instance focuses only on two of these factors, i.e., “the amount of direction provided by the inventor” and “the quantity of experimentation needed to make or use the invention based on the content of the disclosure.”

Various calculations for determining confidence factors are discussed in a wide variety of textbooks ranging from elementary to advanced statistics. A quick Internet search using [www.Google.com](http://www.Google.com) indicates that these calculations are well known to those having ordinary skill in the art. Interpretation of confidence factors for various statistical scenarios is also well understood in the statistical arts. Applicant asserts that it would not require undue experimentation to calculate a confidence factor, and having done so, one of ordinary skill in the art after becoming familiar with the teachings in Applicant’s specification would then be able to relate the confidence factor to the matched inference metadata to rate how closely the inference metadata matches the captured image.

For at least the foregoing reasons claims 23 and 24 are believed to be allowable and withdrawal of the rejection of claims 23 and 24 is respectfully requested.

**Claim Rejections - 35 U.S.C. 102(b)**

The Office Action rejected claims 1-6, 8, 12-17, and 19 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,469,698 to Fukahori ("Fukahori"). Applicant respectfully traverses this rejection.

Fukahori discloses an image display apparatus for reading absolute-position information indicative of a position from an image recording medium, and selecting and displaying place-name data corresponding to the absolute-position information. Applicant agrees that it is well known to associate GPS data with a place name, e.g., as is commonly done by commercially available GPS systems. This is not, however, what Applicant claims.

Applicant explains at paragraph [0018] that "image metadata may consist of information such as the time the image was recorded, the location of the image, the pointing direction and angle of inclination of the camera when the image was recorded. The image metadata is used to obtain additional information that is added to the image file during post processing. This additional information is classified as inference information. The image metadata is used to locate inference information from external sources. The inference information can be used to further identify or define the content of the image."

Claim 1 is amended to clarify "searching one or more information sources using parameters in the image metadata to collect inference information from the information sources, the inference information including field of view information and location identification information." This

amendment is supported by the specification as originally filed, e.g., at paragraph [0019]-[0020].

Specifically, paragraph [0019] explains that inference information may include “terrestrial features at or near where the image was captured” using the U.S. Geological Survey website or database. Paragraph [0020] further explains the use of field of view information and that the inference information thus allows the photographer “to remember and tell the ‘whole story’ associated with the image.” Telling the “whole story” goes beyond simply identifying the location of the photograph as disclosed by Fukahori.

Applicant believes the amendment makes this distinction clear. However, the Examiner is requested to telephone the below-listed attorney if additional amendment is believed to be necessary to clarify this distinction for allowance of the claims.

For at least the foregoing reasons claim 1 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claims 2-6, and 8 depend from claim 1, which is believed to be allowable. Therefore, claims 2-6, and 8 are also believed to be allowable for at least the same reasons as claim 1. Withdrawal of the rejection of claims 2-6, and 8 is respectfully requested.

In addition, claim 2 further recites “receiving one or more inputs from the user identifying selected inference information; and adding the selected inference information to an image file for the image.” Claim 3 further recites “receiving one or more inputs from the user identifying selected inference

information; and adding the selected inference information to an inference metadata file linked to the image.” As discussed above, there is no teaching or suggestion of user selected *inference information* in the cited references.

Claim 12 is also amended to clarify “means for searching an information source using the image metadata to identify image inference information, the inference information including location identification and at least one other type of data based on the image metadata.” At least these recitations are believed to be allowable, as discussed above for claim 1. Therefore, claim 12 is believed to be allowable and Applicant respectfully requests withdrawal of the rejection of claim 12.

Claims 13-17, and 19 depend from claim 12, which is believed to be allowable. Therefore, claims 13-17, and 19 are also believed to be allowable for at least the same reasons as claim 12. Claims 13 and 14 are also believed to be allowable for the separate reasons discussed above for claims 2 and 3. Withdrawal of the rejection of claims 13-17, and 19 is respectfully requested.

**Claim Rejections - 35 U.S.C. 103(a) - Fukahori and Tsujimoto**

The Office Action rejected claims 7 and 18 under 35 U.S.C. 103(a) as being unpatentable over Fukahori in view of U.S. Patent No. 6,961,096 to Tsujimoto (“Tsujimoto”). Applicant respectfully traverses this rejection.

Claim 7 depends from independent claim 1 and claim 18 depends from independent claim 12. The independent claims are believed to be allowable for at least the reasons discussed above. Furthermore, Tsujimoto fails to make up for the deficiency discussed above for claims 1 and 12. Therefore it follows

that claims 7 and 18 are also allowable for at least the same reasons as the respective independent claims. Withdrawal of the rejection of claims 7 and 18 is respectfully requested.

**Claim Rejections - 35 U.S.C. 103(a) - Fukahori and Paolini**

The Office Action rejected claims 9-11 and 20-22 under 35 U.S.C. 103(a) as being unpatentable over Fukahori in view of U.S. Patent Publication No. 2004/0114042 to Paolini, et al. ("Paolini"). Applicant respectfully traverses this rejection.

Claims 9-11 depend from independent claim 1. Claim 1 is believed to be allowable for at least the reasons discussed above. Furthermore, Paolini fails to make up for the deficiency discussed above for claim 1. Therefore it follows that claims 9-11 are also allowable for at least the same reasons as claim 1. Withdrawal of the rejection of claims 9-11 is respectfully requested.

Claims 20-22 depend from independent claim 12. Claim 12 is believed to be allowable for at least the reasons discussed above. Furthermore, Paolini fails to make up for the deficiency discussed above for claim 12. Therefore it follows that claims 20-22 are also allowable for at least the same reasons as claim 1. Withdrawal of the rejection of claims 20-22 is respectfully requested.

**New Claims**

New claims 25-30 have been added. No new subject matter is added by the inclusion of these claims. Support is found in the specification as originally filed, e.g., in paragraphs [0047]-[0049]. Applicant believes that the recitations

of these new claims are not disclosed or rendered obvious in view of the cited references and allowance of these new claims is respectfully requested.

**Conclusion**

The Applicant respectfully requests that a timely Notice of Allowance be issued in this matter.

Respectfully Submitted,

/Mark D. Trenner/

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By: \_\_\_\_\_

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